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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,575	05/25/2006	Jin Fujino	SHIGA1.005APC	5358

20995 7590 03/02/2009  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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HEYER, DENNIS

ART UNIT	PAPER NUMBER
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4121

NOTIFICATION DATE	DELIVERY MODE
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03/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/580,575	FUJINO ET AL.	
	Examiner	Art Unit	
	DENNIS HEYER	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

*Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 – 7 drawn to an oil-in-water cosmetic composition

Group II, claim(s) 8 – 11, drawn to a method of producing an oil-in-water cosmetic composition.

As set forth in Rule 13.1 of the Patent Cooperation Treaty (PCT), "the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." Moreover, as stated in PCT Rule 13.2, "where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." Furthermore, Rule 13.2 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

The inventions listed as Groups I – II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I, an oil-in-water cosmetic composition recited in Claim 1, is anticipated by the prior art. As disclosed in Fujino *et al.* (US2006/0286133 A1, filed 05/07/2004; published: 12/21/2006, this reference teaches the elements comprising instant Claim 1. Component A and B are disclosed in Claim 1 (page 6, paragraph 6 and page 7, paragraph 2). The limitations of components A and B are disclosed as follows: "A self emulsification type oily liquid cosmetic composition comprising 8 to 30% by mass of a component A and 50 to 92% by mass of a component B, wherein the component A is a polyglycerin fatty acid ester having a hydroxyl value of 450 to 700, and a branched fatty acid residue having 16 to 18 carbon atoms and/or a linear unsaturated fatty acid residue having 16 to 18 carbon atoms accounting for 50 to 100% by mass of total constituent fatty acid residues, and in a polyglycerin constituting the polyglycerin fatty acid ester, a total content of a polyglycerin cyclic compound of a dimer and a trimer is from 0 to 3% based on the entire polyglycerin, a total content of a polyglycerin of a undecamer or a higher multimer is from 10 to 30% based on the entire polyglycerin, and each content of a polyglycerin of a tetramer to a decamer is from 4 to 20% based on the entire polyglycerin." The dispersability in water, Component C, of the oily composition comprising components A and B is disclosed on, for example: page 12, section [00118] and page 14, section [0142]. Thus the elements of the subject matter relating to Group I of the instant application are not novel over the prior art.

As such, Group I does not share a special technical feature with the instant claims of Group II. Therefore, the claims are not so linked within the meaning of PCT

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Rule 13.2 so as to form a single inventive concept, and unity between Groups I and II is broken.

### *Election of Species*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

If Group I is elected, EACH of the following species elections is required:

1. Regarding Claim 1:

a) Elect a single component compound A as disclosed on pages 9 – 13 of the instant specification, or otherwise disclosed, with Claims 1 – 7 reading upon this species. Indicate, for the elected component A, from which specific polyglycerin compound and which specific fatty acid compound component A is derived, as disclosed on pages 23 – 32 of the specification, or otherwise disclosed. For this species, Claims 1 – 7 are generic for Group I.

b) Elect a single oily component compound B, as disclosed on pages 13 – 15 of the instant specification, or otherwise disclosed, with Claims 1 – 7 reading upon this species. For this species, Claims 1 – 7 are generic for Group I.

2. Specify whether or not Component D (Claim 3) of the cosmetic composition of Claim 1 is present. If present, elect a single polyhydric alcohol alkyl ether compound, as disclosed on pages 16 – 17 of the instant specification, or otherwise

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disclosed with Claims 3 – 4 reading upon this species. For this species, Claims 1 – 2 and 4 – 7 are generic for Group I.

3. Specify whether or not, a thickener (Claim 6) of the cosmetic composition of Claim 1 is present. If present, elect a single thickener compound, as disclosed on pages 18 – 19 of the instant specification, or otherwise disclosed, with Claim 6 reading upon this species. For this species, Claims 1 – 5 and 7 are generic for Group I.

4. Elect at least one of the form species disclosed in Claim 7 (lipstick, cleansing gel, shampoo, etc.) that is applicable to the component species elected in 1, 2 and 3 above, with Claim 7 reading upon this species. For this species, Claims 1 – 6 are generic for Group I.

If Group II is elected, EACH of the following species elections is required:

1. Regarding Claims 8 and 10: Elect a single method for producing the oil-in-water emulsion from either Claim 8 or Claim 10. If Claim 8 is elected, Claims 8 and 9 read upon this species and Claims 8 and 9 are generic for Group II. If Claim 10 is elected, Claims 10 and 11 read upon this species and Claims 10 and 11 are generic for Group II.

2. Elect a single component compound A as disclosed on pages 9 – 13 of the instant specification, or otherwise disclosed, with Claims 8 – 11 reading upon this species. Indicate, for the elected component A, from which specific polyglycerin compound and which specific fatty acid compound component A is derived, as

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disclosed on pages 23 – 32 of the specification, or otherwise disclosed. For this species, Claims 8 – 11 are generic for Group II.

3. Elect a single oily component compound B, as disclosed on pages 13 – 15 of the instant specification, or otherwise disclosed, with Claims 8 – 11 reading upon this species. For this species, Claims 8 – 11 are generic for Group II.

4. If the method of Claim 10 is elected (above), elect a single polyhydric alcohol alkyl ether compound, as disclosed on pages 16 – 17 of the instant specification, or otherwise disclosed with Claims 10 – 11 reading upon this species. For this species, Claims 10 – 11 are generic for Group II.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or

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corresponding special technical features in that members of each species election above have previously been disclosed by Fujino *et al.*

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.



Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP

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§ 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS HEYER whose telephone number is (571)270-7677. The examiner can normally be reached on Monday-Friday 8AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Patrick J. Nolan/

Supervisory Patent Examiner, Art Unit 4121